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EXAMINER

PIAZZA CORCORAN, GLADYS JOSEFINA

ART UNIT	PAPER NUMBER
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1733

DATE MAILED: 07/02/2003

5

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/961,126

Applicant(s)

SCHMIDT, STEPHEN R.

Examiner

Gladys J Piazza Corcoran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 1-9,13,14 and 18-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 10-12 and 15-17 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3,4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-9, drawn to a method of manufacturing corrugated board, classified in class 156, subclass 205.
 - II. Claims 10-19, drawn to an apparatus for manufacturing a corrugated product, classified in class 156, subclass 462.
 - III. Claim 20, drawn to a corrugated article, classified in class 428, subclass 182.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process as claimed can be practiced by another materially different apparatus, for example without a corrugating device as required by the apparatus claims, the method claims only require a supply of corrugated material.
3. Inventions I and III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another

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and materially different process such as without applying a wetting agent, by using a more aqueous adhesive, or applying a wetting agent to the second web.

4. Inventions II and III are related as apparatus and product made. The inventions in this relationship are distinct if either or both of the following can be shown: (1) that the apparatus as claimed is not an obvious apparatus for making the product and the apparatus can be used for making a different product or (2) that the product as claimed can be made by another and materially different apparatus (MPEP § 806.05(g)). In this case the product as claimed can be made by another and materially different apparatus such as without a wetting device, or a wetting device that applies wetting agent to the medium prior to corrugation or to the second web.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

7. This application contains claims directed to the following patentably distinct species of the claimed invention:

Species I, where the water supply device is an anilox system, (Apparently: Group I claim 4; Group II claims 12, 13, 14, 18, 19).

Species II, where the water supply device is a sprayer, (Apparently: Group I claim 4; Group II claim 12).

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Species III, where the water supply device is a plurality of rollers, (Apparently: Group I claim 4; Group II claim 12).

Species IV, where the water supply device is a rod coater, (Apparently: Group I claim 4; Group II claim 12).

Species V, where the water supply device is a belt system, (Apparently: Group I claim 4; Group II claim 12).

Species A, where the adhesive is a starch composition, (Apparently: Group I, claim 5).

Species B, where the adhesive is a water based adhesive composition, (Apparently: Group I, claim 5).

Species X, where the anilox system has a doctor blade, (Apparently: Group II, claim 13).

Species Y, where the anilox system has a second roll, (Apparently: Group II, claims 14, 18, 19).

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-3, 6-11, 15-17, 20 appear to be generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim

is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

8. During a telephone conversation with Tom Miller (312-474-6300) on June 26, 2003 a provisional election was made with traverse to prosecute the invention of Group II, Species II, claims 10-12, 15-17. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-9, 13, 14, 18-20 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 112

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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10. Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

11. Claim 12 recites, "where the wetting device comprises one of an anilox system, a sprayer, a plurality of rollers, a rod coater, and a belt system". The claim is unclear because the anilox system, the plurality of rollers, the rod coater, and the belt system embodiments refer to non-elected Species. Only the sprayer is elected. It is noted that rejoinder will be considered upon indication of allowable subject matter and the basis thereof.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. Claims 10-12, 15-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Swift (US Patent No. 1,199,508).

Swift discloses an apparatus for manufacturing a corrugated product with a corrugating device (rollers 2,3) for forming a plurality of flutes on a medium web (web 1, corrugated web 4), a wetting device to apply a wetting agent to the crests (spraying device 6), an adhesive supply device to apply adhesive to the crests (rollers 29 and 30), and a securing device to secure a second web of medium to the crests (roller 9). As to claim 11, the corrugating device comprises a first corrugating roll and a second

corrugating roll (rollers 2,3). As to claim 12, the wetting device comprises a sprayer (sprayer 6). As to claim 15, the wetting device is adapted to apply wetting agent to the crests prior to the adhesive supply device (see figure I). As to claim 16, there is a second wetting device for applying wetting agent to the crests on the second side of the single faced corrugating board (sprayer 17). As to claim 17, there is a second adhesive supply device for applying adhesive to the crests on the second side of the first web (rollers 29 and 30).

14. Claims 10-12, 15-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Wallick '391 (US Patent No. 5,292,391) or Wallick '458 (US Patent No. 5,332,458).


Wallick '391 and Wallick '458 both disclose an apparatus for manufacturing a corrugated product with a corrugating device for forming a plurality of flutes on a medium web (rollers 38 and 40), a wetting device to apply a wetting agent to the crests (spray 48), an adhesive supply device to apply adhesive to the crests (glue station 42), and a securing device to secure a second web of medium to the crests (pressure roll 36). As to claim 11, the corrugating device comprises a first corrugating roll and a second corrugating roll (rollers 38 and 40). As to claim 12, the wetting device comprises a sprayer (spray 48). As to claim 15, the wetting device is adapted to apply wetting agent to the crests prior to the adhesive supply device (see figure 1a). As to claim 16, there is a second wetting device for applying wetting agent to the crests on the second side of the single faced corrugating board (sprayer 61). As to claim 17, there is a second adhesive supply device for applying adhesive to the crests on the second side of the first web (adhesive station 60).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gladys J Piazza Corcoran whose telephone number is (703) 305-1271. The examiner can normally be reached on M-F 8am-5:30pm (alternate Fridays off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Ball can be reached on (703) 308-2058. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.


Gladys J Piazza Corcoran
Examiner
Art Unit 1733

GJPC
June 30, 2003